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EXAMINER				
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BERTRAM V. BURKE

Appeal 2010-000437
Application 09/314,424
Technology Center 3600

Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI and BIBHU
R. MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-28 and 30-46. Claims 29 and 47-54 are cancelled. We have jurisdiction under 35 U.S.C. § 6(b). (2002)

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellant claims a system and method for operating a customer based voucher rebate system. (Specification 1:14-15)

Claim 7, reproduced below, is representative of the subject matter on appeal.

7. A computerized method comprising the steps of:

maintaining, in a system and in computer code, individual identifications assigned to one or more organizations and individual identifications assigned to one or more supporters and individual identifications assigned to one or more merchants, the identifications assigned to one or more supporters incorporated into a transaction card, the transaction card not associated with a traditional credit card;

in the system and in computer code, maintaining a schedule of rebates determined to be contributed by each of the one or more the merchants;

in the system, collecting from the merchant, in computer code, during a transaction between a supporter and a merchant, the

identifications of the supporter and the merchant;
determining, at the time of the transaction, if the transaction
involves a rebate to one or more of the one or more organizations;

calculating, in computer code, the rebates due from the merchant;
and

in the system, crediting the amount of rebates determined by the
one or more merchants, to the one or more organizations selected by
the one or more supporters.

THE REJECTION

The Examiner relies upon the following as evidence of
unpatentability:

Hovakimian	US 5,466,919	Nov. 14, 1995
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“Flowers As A Double Gift” (Flowers), New York Times (May 5,
1990); ProQuest Historical Newspapers The New York Times (1851-
2006)

The following rejections are before us for review.

1. The Examiner rejected claims 1, 2, 7, 8 and 31 under 35 U.S.C.
§112, first paragraph, as failing to comply with the written description
requirement.

2. The Examiner rejected claims 1-28 and 30-46 under 35 U.S.C.
§103(a) as being unpatentable over Hovakimian in view of Flowers.

3. The Examiner rejected claims 1-2, 7-8 and 31 under 35 U.S.C. §103(a) as being unpatentable over Flowers in view of Hovakimian.

ISSUES

Has Appellant shown that the Examiner erred in rejecting claims 1-28 and 30-46 on appeal as being unpatentable under 35 U.S.C. § 103(a) over Hovakimian in view of "Flowers as a Double Gift" on the grounds that a person with ordinary skill in the art would understand that the BAX number on the credit card in Hovakimian could be used separately from the credit card on which it is disclosed?

Has Appellant shown that the Examiner erred in rejecting claims 1, 2, 7, 8 and 31 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement?

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. The Specification describes a transaction card only as a means of inputting the user ID at the POS stating:

The network, instead of issuing and handling scrip, provides each supporter with an individual account, a secure personal identification number (PIN), and a card/device means to enter their ID and purchasing activity into an entry terminal (cash register). At the time of store purchasing the

supporter will hand the clerk a transaction card (TC) transaction card (TC) with the ID being: (a.) bar code encoded, (b) mag stripe encoded, or (c) numerically printed on the card, activate a radio frequency device (FQ), or keystroke in their account number.

(Specification 6:19-27).

2. Hovakimian discloses:

On the back side of the card 10, there are usually located a magnetic strip 15 containing magnetically encoded account identification, and a separate non-magnetic strip for the cardholder signature 17. It is proposed to add to the magnetic strip 15, magnetically encoded alpha numeric data 16 indicating a selected charity to receive a donation. It is not imperative that the added alpha numeric 'charity ID' data be placed at one end of the magnetic strip. The data may be placed at any location along the strip determined as convenient for the card reader equipment.

(Col.2 ll. 31-40).

3. An ordinary and customary definition of the term "associated" as defined inter alia by Merriam Webster's Collegiate Dictionary (10th ed.) is: "to join or connect together".

(<http://www.merriam-webster.com/dictionary/associate>)

4. The Examiner found with respect to the limitation of a central clearinghouse that:

...Hovakimian discloses, inter alia, a "bank card-expedited system" or BAX or independent central clearinghouse, which performs the functions of a

(independent) central clearinghouse for processing a card user's (donor's) purchase during a transaction at a participating or identified merchant's/vendor's POS, once the merchant's POS system establishes a connection with the bank card-expedited system or BAX or clearinghouse and paying a previously decided or determined amount (calculated rebate) to the identified charity or charities resulting from an identified customer's or card bearer's purchase at the identified merchant or POS (fig.3). Here, the central clearinghouse or BAX is independent from or not being controlled by the non-profit organizations, the donors/purchasers and the vendors or retailers/merchants themselves.

(Answer 26).

ANALYSIS

We affirm the rejection of claims 1-28 and 30-46 under 35 U.S.C. § 103(a); and we affirm-in-part the rejection of claims 1,2,7,8 and 31 made under 35 U.S.C. 112, first paragraph.

The rejection under 35 U.S.C. §112, first paragraph

In rejecting claims 1,2,7,8, and 31 under 35 U.S.C. 112, first paragraph, the Examiner maintains that the Specification does not explicitly/immediately support the transaction card not associated with a credit card, or that the transaction occurs independent of a credit card transaction. (Answer 3)

In reply, Appellant argues that the Specification implicitly provides support for the involved claim limitations. (Appeal Br. 7-8)

We find that the Specification describes a transaction card only as a means of inputting the user ID at the POS station (FF 1), and not as a means for paying for the transaction as would be the case for a traditional credit card. Therefore, the Specification does not associate the transaction card with a credit card, and thus provides support for the limitation that the transaction card is not associated with a credit card. Nor, are we persuaded by the Examiner's finding that the involved claim language need be explicitly or immediately stated in the Specification in order to meet the 35 U.S.C. 112, first paragraph requirement. The factual inquiry for determining whether a specification provides sufficient written description for the claimed invention is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). In our view, the Specification conveys with reasonable clarity to those skilled in the art that the transaction card is not associated with a credit card, and thus we will not sustain the rejection of claims 1, 2, 7, and 8 which recite this phrase.

However claim 31 is broader and only recites the *transaction occurring independent of a credit card transaction*. Appellant argues that this language means that the system identification information can be entered into the entry terminal without a transaction or credit card (Appeal

Br. 11) - but the claim language reads far broader than this. Rather, the language here is sufficiently broad to preclude the use of a credit card even to pay for the involved purchase which contradicts the check out description in the Specification (FF 1). Thus, we fail to find where the Specification (FF 1) precludes a user from paying for an item with a credit card. Therefore, we will sustain the rejection of claim 31 under 35 U.S.C. 112, first paragraph.

The Rejection of Claims 1-28 and 30-46 under 35 U.S.C. §103(a)

Appellant's arguments against the rejection of each of independent claims 1, 2, 7 and 8 are based on perceived deficiencies of Hovakimian. Inasmuch as Appellant raises the same issue to the transaction card not being associated with a credit card, we thus collectively respond to Appellant's arguments.

We find that Hovakimian discloses a separate magnetic strip 16, associated with a BAX (Bank Expedited Donation). The BAX indicates a selected charity to receive a donation and can be added to the credit card (FF 4). The claims require *the transaction card [is] not associated with a traditional credit card*. We find that an ordinary and customary definition of the term "associated" is to join or connect together (FF 3). We do not find that providing a card, such as Appellant's transaction card, as a separate item versus connecting it to a credit card, such as the BAX magnetic strip 16 and the card 10 in Hovakimian, constitutes a patentable distinction. This is because packaging the BAX with a credit card as opposed to providing the

BAX data and credit data on two separate cards is not a novel or patentable feature in the light of the well-known practice of packaging items in the manner most convenient to the purchaser. *See, Ormco Corp. v. Align Technology, Inc.* 463 F.3d 1299, 1309 (Fed.Cir. 2006); *see also, In re Larson*, 340 F.2d 965, 968 (CCPA 1965) (the use of a one piece construction instead of two or more would be merely a matter of obvious engineering choice).

Claim 1 includes a further limitation of, *a clearinghouse component, a nonprofit component having one or more nonprofits, a supporter component having one or more supporters, and a merchant component having one or more merchants, with the clearinghouse component connecting the other three components via a variety of entry terminals....*

The Examiner found that the BAX clearinghouse in Hovakimian meets this limitation (FF 4). Appellant however argues that the BAX does not enroll all three components (Appeal Br. 9). We find this argument unpersuasive because it is not based on limitations appearing in claim 1 which merely recites “connecting” and not *enrolling* as argued by Appellants. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

Moreover, even if Appellant did accurately restate the claim language here, a statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. *See*, 37 C.F.R. § 41.37 (c)(1)(vii) (2004).

Appellant argues that the limitation in claim 31 of “the transaction

occurring independent of a credit card transaction” distinguishes over Hovakimian because “Hovakimian requires the use of a credit card and is initiated based on a credit card transaction.” (Appeal Br. 11). We find this argument unpersuasive for the same reasons set forth above with respect to claims 1, 2, 7 and 8.

We also affirm the rejections of dependent claims 3-6, 9-27, 28, 30 and 32-46 since Appellants have not challenged such with any reasonable specificity (see *In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987)).

For the same reasons set forth above we affirm the rejection of claims 1,2,7,8 and 31 over Flowers in view of Hovakimian.

CONCLUSIONS OF LAW

We conclude the Appellant has not shown that the Examiner erred in rejecting claims 1-28, and 30-46 under 35 U.S.C. § 103(a).

We conclude the Appellant has not shown that the Examiner erred in rejecting claim 31 under 35 U.S.C. 112, first paragraph.

We conclude the Appellant has shown that the Examiner erred in rejecting claims 1, 2, 7 and 8 under 35 U.S.C. 112, first paragraph.

Appeal 2010-000437
Application 09/314,424

DECISION

The decision of the Examiner to reject claims 1-28 and 30-46 is affirmed.

AFFIRMED

MP

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